

Express Mail Label No. EV 783 700 872 US
Application No. 10/759,593
Attorney Docket No. 49942-296293

REMARKS

This Amendment is filed in response to the Non-final Office Action mailed on September 1, 2006, and is intended to be responsive to every issue raised in that Action. This Response is considered to be timely in view of the three (3) month shortened statutory period for response that was set forth in the Action, the Federal holidays of January 1st and 2nd, and the petition for an extension of time of one (1) month and the appropriate fee therefor, which are enclosed herewith.

Applicants make this Amendment without prejudice or disclaimer. In making this Amendment, Applicants have added no new matter. Support for the amendments above can be found in the specification and claims as filed. Claims 3, 11-17, 27, 30, 35, 39, and 40 have been withdrawn by the Office from consideration. Claims 39 and 40 have been canceled without prejudice or disclaimer. Claims 1, 4-10, 18-26, 28, 29, 31-34, 36-38, and 41 are pending in the Application. Reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and the following remarks.

The Office Action rejects claims 1, 4-10, 18-26, 28, 29, 31-34, and 36-38 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 4-8, 10, 18-21, and 23-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by European Patent Application No. EP 0 674 082 A1 (hereinafter “EP ‘082”). Claims 1, 4-8, 10, 18-26, 28, 29, 31-34, and 36-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,826,878 to Rovtar (hereinafter “Rovtar”). Claims 9 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP ‘082.

A. Claims 1, 4-10, 18-26, 28, 29, 31-34, and 36-38

Claims 1, 4-10, 18-26, 28, 29, 31-34, and 36-38 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action states that, “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The description fails to define exactly what ‘a rounded surface’ is, structurally. It cannot be understood how the rounded surface is related to the insert or to the housing.” Office Action at p. 2.

The claim element “rounded surface” has been deleted from claims 1, 4-10, and 18-26. The “rounded surface” claim element was never recited by claims 28, 29, 31-34, and 36-38. Notwithstanding the deletion or absence of this claim element, Applicants respectfully assert that “a rounded surface” meets the written description requirement of 35 U.S.C. § 112, first paragraph.

“An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention.” MPEP § 2163 (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)). The rounded surface is described in several places in the originally-filed specification, for example at ¶[0102] of the published application (i.e., Patent Application Publication No. US 2005/0132532 A1). This paragraph describes that in one exemplary

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embodiment, an insert was cut from a cylindrical rod and that “the ends [of the cylinder] were rounded to provide a smooth surface at the edges of the cylinder.” ¶[0102] (emphasis added).

This rounded surface is further shown in the Figures as reference numeral 24 at, for example, Figures 5 and 6. The rounded surface can also be seen near reference numeral 20 in Figures 7, 9, 11, 12a, and 12b.

These figures show how a generally cylindrical insert is rounded at its ends to provide a convex surface that is “sturdy enough to support the weight of the sliding panel … [and to] facilitate sliding of the panel.” See ¶[0054]. “In an embodiment, the sliding surface is adjacent to, and abuts, a sliding track.” See ¶[0061]. Therefore, a terminal end of the insert must provide a sliding surface while supporting the weight of a panel. A cylindrical insert having an end with a rounded, convex, or spherical shape or surface (See ¶[0078]) is well-suited to support the weight of a panel and to provide a reduced-friction surface for sliding along a track.

For the reasons set forth above, Applicants respectfully assert that “a rounded surface” meets the written description requirement of 35 U.S.C. § 112, first paragraph. Accordingly, the rejections to claims 1, 4-10, 18-26, 28, 29, 31-34, and 36-38 should be withdrawn and the claims allowed.

B. Claims 1, 4-8, 10, 18-21, and 23-26

Claims 1, 4-8, 10, 18-21, and 23-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by EP ‘082. Applicants respectfully assert that the rejection under 35 U.S.C.

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§ 102(b) is improper because EP '082 does not disclose each and every element of the claims at issue. A claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. See MPEP § 2131 (citing Verdegal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051 (Fed. Cir. 1987)).

1. Claims 1, 4-8, 10, and 18-21

As amended, claim 1 claims an assembly for a panel, which includes among other elements, "a terminal end surface of the insert comprises a convex surface." Claims 4-8, 10, and 18-21 depend ultimately from claim 1.

EP '082 does not disclose an assembly for a panel that includes "a terminal end surface of the insert comprises a convex surface," as claimed. Rather EP '082 describes a device with an adjustment element 6, which includes a flat face that is "made solid to the wall frame 3...." (EP '082 at col. 3, ll. 37-44; see also Figs. 1-4). As the device in EP '082 is made solid and secured to the frame with a flat face, EP '082 does not disclose "a terminal end surface of the insert comprises a convex surface."

Support for this amendment can be found in several places in the originally-filed specification. For example, a convex, terminal end surface is shown in the figures as reference numeral 24 at, for example, Figures 5 and 6. The convex, terminal end surface can also be seen near reference numeral 20 in Figures 7, 9, 11, 12a, and 12b. Paragraph [0078] of the published patent application (Patent Application Publication No. US 2005/0132532 A1) also describes that a cylindrical insert has an end with a spherical shape. Further support for

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this amendment can be found in the specification through express, implicit, and inherent disclosure.

As EP '082 does not disclose each and every element of claim 1, Applicants respectfully submit that claim 1 is patentable over EP '082. Claims 4-8, 10, and 18-21 depend ultimately from claim 1, and are, therefore, also allowable for at least the same reasons as claim 1. Accordingly, the rejections to claims 1, 4-8, 10, and 18-21 should be withdrawn and the claims allowed.

2. Claims 23-26

As amended, independent claim 23 claims an assembly for a panel, which includes among other elements, "a terminal end surface face of the button comprises a spherical shape." Claims 24-26 depend from independent claim 23. Support for this amendment can be found in the specification through express, implicit, and inherent disclosure as described above.

EP '082 does not disclose an assembly for a panel that includes "a terminal end surface of the button comprises a spherical shape," as claimed. Rather EP '082 describes a device with an adjustment element 6, which includes a flat face that is "made solid to the wall frame 3...." (EP '082 at col. 3, ll. 37-44; see also Figs. 1-4). As the device in EP '082 is made solid and secured to the frame with a flat face, EP '082 does not disclose "a terminal end surface of the button comprises a spherical shape."

As EP '082 does not disclose each and every element of independent claim 23, Applicants respectfully submit that independent claim 23 is patentable over EP '082. Claims 24-26 depend from independent claim 23, and are, therefore, also allowable for at least the

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same reasons as independent claim 23. Accordingly, the rejections to claims 23-26 should be withdrawn and the claims allowed.

C. Claims 1, 4-8, 10, 18-26, 28, 29, 31-34, and 36-38

Claims 1, 4-8, 10, 18-26, 28, 29, 31-34, and 36-38 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rovtar. Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) is improper because Rovtar does not disclose each and every element of the claims at issue. As described above, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found.

1. Claims 1, 4-8, 10, 18-22

As amended, claim 1 claims an assembly for a panel, which includes among other elements, “a terminal end surface of the insert comprises a convex surface.” Claims 4-8, 10, and 18-22 depend ultimately from claim 1.

Rovtar does not disclose an assembly for a panel that includes “a terminal end surface of the insert comprises a convex surface,” as claimed. Rather Rovtar describes a flat head 126 of a window shim 46 that is secured to a stud 44. (Rovtar at col. 5, ll. 25-26; see also Figs. 1-4). Thus, Rovtar does not disclose “a terminal end surface of the insert comprises a convex surface.”

As Rovtar does not disclose each and every element of claim 1, Applicants respectfully submit that claim 1 is patentable over Rovtar. Claims 4-8, 10, and 18-22 depend ultimately from claim 1, and are, therefore, also allowable for at least the same reasons as claim 1.

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Accordingly, the rejections to claims 1, 4-8, 10, and 18-22 should be withdrawn and the claims allowed.

2. Claims 23-26

As amended, independent claim 23 claims an assembly for a panel, which includes among other elements, “a terminal end surface of the button comprises a spherical shape.” Claims 24-26 depend from independent claim 23.

Rovtar does not disclose an assembly for a panel that includes “a terminal end surface of the button comprises a spherical shape,” as claimed. Rather Rovtar describes a flat head 126 of a window shim 46 that is secured to a stud 44. (Rovtar at col. 5, ll. 25-26; see also Figs. 1-4). Thus, Rovtar does not disclose “a terminal end surface of the button comprises a spherical shape.”

As Rovtar does not disclose each and every element of independent claim 23, Applicants respectfully submit that independent claim 23 is patentable over Rovtar. Claims 24-26 depend from independent claim 23, and are, therefore, also allowable for at least the same reasons as independent claim 23. Accordingly, the rejections to claims 23-26 should be withdrawn and the claims allowed.

3. Claims 28, 29, 31-34, and 36-38

As amended, independent claim 28 claims an article, which includes among other elements, “means for adjusting a position of the panel with respect to the track.” Claims 29, 31-34, and 36-38 depend ultimately from independent claim 28. The undersigned thanks the Examiner for indicating on the Interview Summary that claim 28 appears to be allowable.

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Rovtar does not disclose an assembly for a panel that includes “means for adjusting a position of the panel with respect to the track,” as claimed. Rather Rovtar describes a window shim for “shimming laterally from, and fastening the sides of a window to, the sides or studs of an opening through a wall.” (Rovtar at col. 1, ll. 17-19; see also Figs. 1 and 7) (emphasis added). Rovtar does not disclose a track supporting the panel in a frame. Moreover, Rovtar does not disclose a means for adjusting a position of the panel with respect to the track. Furthermore, the window in Rovtar is fastened to the studs, and thus, cannot be adjusted or repositioned. Therefore, Rovtar does not disclose “means for adjusting a position of the panel with respect to the track.”

As Rovtar does not disclose each and every element of independent claim 28, Applicants respectfully submit that independent claim 28 is patentable over Rovtar. Claims 29, 31-34, and 36-38 depend ultimately from independent claim 28, and are, therefore, also allowable for at least the same reasons as independent claim 28. Accordingly, the rejections to claims 28, 29, 31-34, and 36-38 should be withdrawn and the claims allowed.

D. Claims 9 and 22

Claims 9 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over EP ‘082. The rejection under 35 U.S.C. § 103(a) is improper because EP ‘082 does not teach or suggest all the claim elements of each of claims 9 and 22. One of the criteria for a *prima facie* case of obviousness is that “the prior art reference (or references when combined) must teach

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or suggest all the claim limitations.” See MPEP § 2143. The cited reference does not teach or suggest all the claim elements of each of claims 9 and 22.

Dependent claims include all the elements of the claim from which they depend. Thus, claims 9 and 22 each claims an assembly for a panel, which includes among other elements, “a terminal end surface of the insert comprises a convex surface.”

As discussed above, EP ‘082 does not disclose an assembly for a panel that includes “a terminal end surface of the insert comprises a convex surface,” as claimed. Rather EP ‘082 describes a device with an adjustment element 6, which includes a flat face that is “made solid to the wall frame 3....” (EP ‘082 at col. 3, ll. 37-44; see also Figs. 1-4). As the device in EP ‘082 is made solid and secured to the frame with a flat face, EP ‘082 does not disclose “a terminal end surface of the insert comprises a convex surface.”

As EP ‘082 does not teach or suggest all the claim elements of each of claims 9 and 22, Applicants respectfully submit that claims 9 and 22 are each patentable over EP ‘082. Accordingly, the rejections to claims 9 and 22 should be withdrawn and the claims allowed.

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CONCLUSION

Applicants respectfully submit that the pending claims are allowable. Applicants respectfully solicit the issuance of a timely Notice of Allowance for all pending claims. The Examiner is invited to contact the undersigned by telephone to discuss any matter related to the Application.

Respectfully submitted,

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